

REMARKS

This responds to the Final Office Action dated January 6, 2009.

No claims are amended, no claims are canceled, and no claims are added; as a result, claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260-262 remain pending in this application.

Substitute Oath/Declaration

The substitute declaration filed on May 29, 2008 was found defective. Corrected substitute declaration is being filed herewith.

§ 251 Rejection of the Claims

Claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260 and 262 were rejected under 35 U.S.C. § 251 as "being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based."¹

A brief reference to the prosecution history may be useful here. The issue of recapture under 35 U.S.C. § 251 has already been raised before, in the Final Office Action dated May 5, 2006. Following the Applicants' arguments, the rejection of claims under 35 U.S.C. § 251 was withdrawn. Specifically, in the Office Action mailed on May 03, 2007, the Examiner stated the reason for withdrawing the rejection under 35 U.S.C. § 251 being that the subject matter of the claims is new and not related to the claimed subject matter surrendered in the patent application upon which the present reissue is based.

Referring to the discussion provided in the Final Office Action mailed January 6, 2009, the Examiner states that claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260 and 262 are broader than the patented claims 1-9 because they do not include limitations recited in the patented claims 1-9 and concludes that the claims are barred by the recapture rule. The recapture

¹ Final Office Action mailed January 6, 2009, page 4.

rule and the scenarios under which the recapture rule bars reissue claims are addressed in MPEP 1412.02 titled "Recapture of Canceled Subject Matter." In the pertinent part, MPEP 1412.02 states that if the reissue claims are claiming additional inventions or embodiments not originally claimed, then recapture is not present, and that the complete removal of a limitation that was added to obtain the patent is permitted where the replacement limitation provides a separate invention.²

In the present reissue application, the claims are directed to method and system of facilitating ordering an item, where the order is placed in response to a single action by the user, and thus are related to additional inventions when compared to the inventions claimed in the original patent (e.g., a system configured to receive and execute a distributed computing application that alters an associated video program). Because the reissue claims are claiming additional inventions not originally claimed, the recapture is not present. It is respectfully requested that the rejection be reconsidered and withdrawn.

The Finality of the Office Action is Improper

Pursuant to MPEP 706.07(a), "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement."³ Claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260 and 262 were rejected under 35 U.S.C. § 251 as "being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based."

It will be noted that the Office Action immediately preceding the Final Office Action dated January 6, 2009 did not set forth a rejection under 35 U.S.C. § 251 for the reason of improper recapture. Thus, because the Examiner was silent in the earlier paper with respect to the issue of recapture and, as a result, the Applicants were not afforded an opportunity to

² MPEP 1412.02 (I)(C). ("If, however, the reissue claim(s) are really claiming additional inventions/embodiments/species not originally claimed (i.e., overlooked aspects of the disclosed invention), then recapture will not be present.")

³ Final Office Action mailed January 6, 2009, page 4.

respond, the rejection of the claims as improper recapture is a new ground of rejection⁴ that renders the Final Office Action dated January 6, 2009 an improper Final Office Action. It is respectfully requested that the finality of the Final Office Action be withdrawn.

Furthermore, it will be noted that the Applicants submitted the substitute declaration in reliance on the Examiner's input with respect to the proposed substitute declaration. Specifically, the allegedly defective declaration was revised by and informally approved by the Examiner, as is evident from the documents provided in Appendix A (email exchange between the Applicants' representative and the Examiner), Appendix B (Applicants' proposed substitute declaration), and Appendix C (substitute declaration revised by the Examiner). Because the substitute declaration was filed on May 29, 2008 in reliance on the informal approval by the Examiner, the rejection of the substitute declaration as defective is equivalent to a new ground of rejection by the Examiner. Therefore, the Final Office Action dated January 6, 2009 is an improper Final Office Action. It is respectfully requested that the finality of the Final Office Action be withdrawn for this additional reason.

One-Click Patent

The Office should be aware of U.S. patent no. 5,960,411, conventionally known as Amazon One-Click patent, that claims certain aspects of placing an order for an item in response to a single action being performed. It will be noted that the priority date of the U.S. patent no. 5,960,411 is September 12, 1997, which is subsequent to the filing date of the original patent that is April 28, 1994. The U.S. patent no. 5,960,411 is thus not prior art with respect to the present reissue application.

⁴ *Ex parte Mahur*, Appeal No. 95-4103, 1996 WL 1795838 at *9.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (408) 278-4052 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 26, 2009.

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